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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,562	11/17/2000	Robert D. Bauer	8462/1	6526

20694 7590 04/14/2004

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EXAMINER

ZHONG, CHAD

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,562

Applicant(s)

BAUER ET AL.

Examiner

Chad Zhong

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one for following inventions is required under 35 U.S.C. 121:

I. Claims 1-28, 34-44, drawn to subscribe to a service and establishing user accounts, classified in class 705, subclass 38.

II. Claims 29-33, drawn to electronic mail filtering, classified in class 345, subclass 752.

The inventions are distinct, each from the other because of the following reasons. Invention II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, invention I has separate utility such as in a establishing user accounts to properly route advertisement while keeping confidentiality of user's email address, and invention II has separate utility such SPAM email filtering, particulars, see MPEP 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, different searches and their recognized divergent subject matter, and the search required for group I is not required for group II, restriction for examination purposes as indicated is proper.

Election for restriction was received on March 26, 2004, the applicant has elected group I, claims 1-28 and 34-44. Claims 29-33 are withdraw from further consideration by examiner, 37 CFR 1.142(b), as being draw to a non-elected invention.

DETAILED ACTION

1. Claims 1-28, 34-44 are presented for examination.
2. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. The disclosure is objected to because of the following informalities:
pg 16, line 22, electronic communication service should be numbered 10 instead of 12.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 6-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 6-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for sorting email advertising materials according to user pre-defined categories (pg 6, lines 1-7), does not reasonably provide enablement for sorting direct mail advertising materials according to predefined categories. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

and/or use the invention commensurate in scope with these claims.

In order to implement the claimed invention, it requires manipulation of the postal system to sort out the postal mail delivered to the end users. However according to applicant's specification of sorting email advertising messages as set forth hereinabove, email advertisements can be sorted in accordance with user's predefined categories. As such, it is not clear how the claimed invention can be implemented while still following the specification of the email sorting based on categories. In summary, applicants fail to teach the specific methods which allow the direct mail advertisements to be sorted.

The Examiner submits that it would require undue experimentation for one of ordinary skill in the art to make and use the invention for reason set forth hereinabove. Applicants are reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 and 37 CFR 1.118(a).

6. Claims 10 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 10 and 25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for allow said users to browse offers matched to a user's categories of interest (pg 16, line 16), does not reasonably provide enablement for allowing users to browse offers unmatched to a user's categories of interest. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

In order to implement the claimed invention, it does not require usage of a email filtration device. However according to applicant's specification of email filtering device as set forth

hereinabove, incoming email advertisements will be filtered in accordance with user's predefined categories (i.e. matched categories of interest). As such, it is not clear how the claimed invention can be implemented while still following the specification of the filtering email based on matched and unmatched categories. In summary, applicants fail to teach the specific methods which allow the unmatched mail advertisements to be viewed.

The Examiner submits that it would require undue experimentation for one of ordinary skill in the art to make and use the invention for reason set forth hereinabove. Applicants are reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 and 37 CFR 1.118(a).

7. Claims 14-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 14-16 stated the charging of a fee to businesses for sending the direct mail advertising materials based on amount of mail the business has sent. However, there is no mentioning of collecting such fees for direct mailing purposes within the specifications. Furthermore, closest item to a fee towards the businesses is found in (pg 37, lines 19-21), which does not suggest or mention the idea of charging a fee for business for direct mailing based on volume of mails sent. Therefore claims 14-16 is unsupported by the specification provided.

Applicants are reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 and 37 CFR 1.118(a).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 18, 20-23, 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (hereinafter Lee), US 6,108,691.

10. As per claim 18, Lee teaches an electronic communication service method for a user comprising:

subscribing to the electronic communication service through a user interface using conventional name and conventional postal address information (Col. 3, lines 17-42; Col. 4, lines 62-67);

obtaining an account (Col. 4, lines 62-67);

providing user preferences (Col. 4, lines 27-34); and

receiving over the Internet mailing information offered by businesses over the electronic communication service and matched to said user preferences (Col. 4, lines 27-34) based upon said conventional name and said conventional postal address information (Col. 3, lines 17-42; Col. 4, lines 27-34).

11. As per claim 20, Lee teaches the method of claim 18 further comprising receiving communications screened for undesired electronic mail and undesired offers (Col. 4, lines 27-34; Col. 5, lines 51-61).

12. As per claim 21, Lee teaches the method of claim 18 wherein correspondences sent and received without disclosing e-mail addresses (Col. 6, lines 35-39; Col. 1, line 51, lines 63-65).

13. As per claim 22, Lee teaches the method of claim 18 wherein said mailing information may be sorted according to categories (Col. 5, lines 51-61; Col 6, lines 3-4).

14. As per claim 23, Lee teaches the method of claim 18 further comprising:
providing e-mail addresses and aliases (Col. 4, lines 27-34; Col. 6, lines 27-39); and
consolidating electronic mail from said e-mail addresses and said aliases at a single location (Col. 2, lines 42-51; Col. 4, lines 48-49; Col. 6, lines 18-22).

15. As per claim 25, Lee teaches the method of claim 18 further comprising browsing offers matched and unmatched against said user preferences (Col. 5, lines 51-61; Col. 4, lines 26-34).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 1-4, 6-13, 19, 24, 26-28, 34-36, 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (hereinafter Lee), US 6,108,691, in view of "Evaluating Web impact – the death of the highway metaphor.", Murray, Jan 1997.

18. As per claim 1, Lee teaches the invention substantially as claimed wherein an electronic communication service method comprising:

subscribing users to the electronic communication service using conventional name and conventional postal address information (Col. 4, lines 62-67);

subscribing businesses to the electronic communication service (Col. 4, lines 48-49, lines 62-67);

sending the e-mail advertising materials to the users over the Internet using the conventional name-and-conventional-postal-address information (Col. 8, lines 30-33; Col. 10, lines 20-26).

19. Lee does not teach:

receiving direct mail advertising materials from the businesses; and
sending the direct mail advertising materials to the users over the Internet.

20. Murray teaches receiving direct mail advertising materials from the businesses (pg 2, lines 1-11); and sending the direct mail advertising materials to the users over the Internet (pg 2, lines 1-11).

21. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Lee and Murray because they both dealing with targeted advertising by the businesses. Furthermore, the teaching of Murray to allow receiving direct mail advertising materials from the businesses; and sending the direct mail advertising materials to users over the Internet would improve functionality for Lee's system by providing the end user with more options in regards to which medium the advertisement arrive.

22. As per claim 2, Lee teaches the method of claim 1 wherein e-mail addresses of said users are maintained in confidence (Col. 1, line 51; Col. 6, lines 35-39).

23. As per claim 3, Lee teaches the method of claim 2 wherein said e-mail addresses are maintained in confidence during and after any transactions between users and businesses (Col. 1, line 51; Col. 6, lines 35-39).

24. As per claim 4, Claim 4 is rejected for the same reason as the rejection to claim 23 above.

25. As per claims 6 and 7, claims 6 and 7 are rejected for the same reason as the rejection to

claim 22 above.

26. As per claim 8, Lee teaches the method of claim 1 further comprising:

obtaining demographic information from the users (Col. 3, lines 17-42);

27. Lee does not teach allowing the businesses to send the direct mail advertising materials to the user based upon said demographic information.

28. Murray teaches allowing the businesses to send the direct mail advertising materials to the user based upon said demographic information (pg 2, lines 1-11).

29. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Lee and Murray because they both dealing with targeted advertising by the businesses. Furthermore, the teaching of Murray to allow the business to send the direct mail advertising materials to the user based upon said demographic information would improve functionality for Lee's system by providing the end user with more options in regards to which medium the advertisement arrive.

30. As per claim 9, Lee does not teach the method of claim 1 further comprising allowing the users to specify types of the direct mail advertising materials which the users wish to receive.

31. Murray teaches the method of claim 1 further comprising allowing the users to specify types of the direct mail advertising materials which the users wish to receive (pg 2, lines 28-31, lines 56-58).

32. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Lee and Murray because they both dealing with targeted advertising by the businesses. Furthermore, the teaching of Murray to allow the users to specify

types of the direct mail advertising materials which the users wish to receive would improve functionality for Lee's system by providing the end user with more options in regards to which medium the advertisement arrive.

33. As per claim 10, Claim 10 is rejected for the same reason as the rejection to claim 25 above.

34. As per claim 11, Lee does not teach the method of claim 1 further comprising sending conventional postal mail when a user does not have an e-mail address or prefers to receive direct mail advertising materials by conventional postal mail.

35. Murray teaches the method of claim 1 further comprising sending conventional postal mail when a user does not have an e-mail address or prefers to receive direct mail advertising materials by conventional postal mail (pg 2, lines 10-11).

36. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Lee and Murray because they both dealing with targeted advertising by the businesses. Furthermore, the teaching of Murray to send conventional postal mail when a user does not have an e-mail address or prefers to receive direct mail advertising materials by conventional postal mail would improve functionality for Lee's system by providing the end user with more options in regards to which medium the advertisement arrive.

37. As per claim 12, Lee teaches the method of claim 1 wherein the conventional name and the conventional postal address information is converted to e-mail addresses through a mapping function (Col. 8, lines 30-34; Col. 10, lines 21-26).

38. As per claim 13, Lee teaches the method of claim 1 further comprising screening

undesired electronic mail and undesired offers from users (Col. 4, lines 27-34; Col. 5, lines 51-61).

39. As per claim 19, Claim 19 is rejected for the same reason as the rejection to claim 8 above.

40. As per claim 24, Claim 24 is rejected for the same reason as the rejection to claim 11 above.

41. As per claim 26, Lee teaches an electronic communication service method for a business comprising:

- subscribing to the electronic communication service (Col. 3, lines 17-41);
- obtaining a business account (Col. 4, lines 41-43);
- providing conventional name and conventional postal address information from the business to the electronic communication service (Col. 4, lines 42-44, lines 48-49); and
- allowing the service to send e-mail advertising materials to a plurality of users over the Internet using said conventional name and said conventional postal address information provided by the business (Col. 8, lines 30-33; Col. 10, lines 20-2).

42. Lee does not teach providing direct mail advertising materials from the business to the electronic communication service; and allowing the service to send direct mail advertising materials to a plurality of users over the Internet.

43. Murray teaches providing direct mail advertising materials from the business to the electronic communication service (pg 2, line 15, lines 56-58); and allowing the service to send direct mail advertising materials to a plurality of users over the Internet (pg 2, lines 10-11).

44. It would have been obvious to one of ordinary skill in this art at the time of invention was

made to combine the teaching of Lee and Murray because they both dealing with targeted advertising by the businesses. Furthermore, the teaching of Murray to allow providing direct mail advertising materials from the business to the electronic communication service; and allowing the service to send direct mail advertising materials to a plurality of users over the Internet would improve functionality for Lee's system by providing the end user with more options in regards to which medium the advertisement arrive.

45. As per claim 27, Lee teaches the method of claim 26 further comprising allowing the business to create target contact lists based upon a plurality of interested users (Col. 8, lines 6-18; Col. 5, lines 40-41; Col. 6, lines 4-5).

46. As per claim 28, Claim 28 is rejected for the same reason as the rejection to claim 19 above.

47. As per claim 34, Claim 34 is rejected for the same reasons as the rejection to claim 1 above.

48. As per claim 35, Lee teaches the method of the method of claim 34 wherein the step of subscribing businesses to the electronic communication service comprises subscribing the businesses at a remote location (Col. 4, lines 63-67).

49. As per claim 36, Lee teaches the method of claim 34 wherein the step of subscribing business to the electronic communication service comprises subscribing the businesses at a local location (Col. 4, lines 27-34; Col. 3, lines 17-42; Col. 8, lines 6-18, lines 30-33).

50. As per claim 37, Claim 37 is rejected for the same reasons as rejection to claim 1 above.

51. As per claims 38-42, 44, Claims 38-42, 44 are rejected for the same reasons as rejection

to claims 2-4, 6, 12, and 25 above respectively.

52. As per claim 43, Lee teaches the apparatus of claim 37 further comprising:

means for receiving conventional Postal address mailing list from the businesses (Col. 1, lines 52-65); and

means for converting said postal address mailing lists to e-mail addresses (Col. 8, lines 30-34; Col. 10, lines 21-26).

53. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (hereinafter Lee), US 6,108,691, in view of "Evaluating Web impact – the death of the highway metaphor.", Murray, Jan 1997, in further view of "UK CASE STUDY: THE POSTAL PREFERENCE SERVICE" Bryan, 1999, in further view of 'Official Notice'.

54. As per claim 14, Lee and Murray does not teach the method of claim 1 further comprising charging the businesses for sending the direct mail advertising materials.

55. Bryan teaches the method of claim 1 further comprising charging the businesses for sending the direct mail advertising materials (pg 4, "How much will this service cost me?", lines 1-4).

56. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Lee, Murray and Bryan because they all deal with targeted advertising by the businesses. Furthermore, the teaching of Bryan to charge the businesses for sending the direct mail advertising materials would answer the question for funding and cost for Lee and Murray's system by charging businesses for using the direct targeted advertisement service.

57. As per claim 15 and 16, Claims 15 and 16 are rejected for the same reason as the rejection to

claim 14 above.

58. As per claim 17, Lee, Murray and Bryan does not teach the method of claim 14 further comprising charging the businesses for converting said conventional postal address mailing lists to e-mail addresses. However, Official Notice is taken by the examiner that charging a fee for registered conversion services is notoriously well known for the advantage of keeping the service from going out of business.

59. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (hereinafter Lee), US 6,108,691, in view of "Evaluating Web impact – the death of the highway metaphor.", Murray, Jan 1997, in further view of "Direct MarketingOnline To Avoid Spam, Check Source Of Email Lists", Interactive PR & Marketing News (hereinafter Interactive), 2 October 1998.

Conclusion

60. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Electronic Communication Service".

- i. "Direct MarketingOnline To Avoid Spam, Check source of email lists", Interactive PR & Marketing News, v5, n20, Oct 2, 1998.
- ii. "competition law – dominant market position – anti-competitive behaviour – Competition Act 1998", Collins, J Feb 11, 2000.
- iii. "UK CASE STUDY: The Postal Preference Service More of the mail you want, less of what you don't" 1999.
- iv. "How a Retailing Stalwart Plans To Apply Precision of Direct Marketing to the Web. (Company Business and Marketing)" Andrews, Whit. Internet World June 14, 1999.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (703) 305-0718. The examiner can normally be reached on M-F 7am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 703-305-8498. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CZ
April 8, 2004


ZARNI MAUNG
PRIMARY EXAMINER